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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/525,477 03/15/00 MIYAZAWA

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MM91/0111
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EXAMINER

NGUYEN, J

ART UNIT	PAPER NUMBER
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2861

DATE MAILED:

01/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/525,477

Applicant(s)
Miyazawa

Examiner
Judy Nguyen

Group Art Unit
2861



☒ Responsive to communication(s) filed on Mar 15, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-59 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-59 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAIL ACTION

Election/Restriction

1. Upon further review, restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-49, 58, 59, drawn to a device directed to a particular subcombination of an ink supply means having at least a spring and a membrane, classified in class 347, subclass 85 and class 137, subclass 852.

Group II. Claims 50-57, drawn to a device directed to a combination of elements for ink-jet recording, classified in class 347, subclasses 85, 86 and 29.

2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, **assumed that the combination and subcombination are to be patentable**, the combination as claimed does not require the

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particulars of the subcombination as claimed because the omission of the limitations such as the spring and movable membrane as defined in Group I. The subcombination I has separate utility to be used in any fluid system required fluid pressure to be regulated in the fluid system.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for Group I is not required for Group II and vice versa, restriction for examination purposes as indicated is proper.
5. In addition, if Group I is elected, Group I is further restricted as follows.

Group I, claims 1-49, 58, 59 directed to the following patentably distinct species of the claimed invention:

- * Species I - Figures 1 - 7(e), 20
- * Species II - Figures 8(a) - 8[©]
- * Species III - Figures 10, 11(a), 11(b)
- * Species IV - Figures 12 - 16(b)
- * Species V - Figure 16[©]
- * Species VI - Figure 16(d)
- * Species VII - Figure 16(e)
- * Species VIII - Figures 17(a), 17(b)
- * Species IX - Figures 18(a), 18(b)
- * Species X - Figures 19(a), 19(b)

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 12 are generic.

6. Furthermore, if Group II is elected, Group II is further restricted as follows.

Group II, claims 50-57 directed to the following patentably distinct species of the claimed invention:

- * Species I - claims 50, 51, 52 directed to a device having supplementing means and both the ink injection port and the air open port sealed while negative pressure is being applied to the recording head
- * Species II - claims 50, 51, 53, 54 directed to a device having supplementing means and only the air open port sealed while negative pressure is being applied to the recording head
- * Species III - claims 55-57 directed to a device having ink tank with plural chambers instead of supplementing means

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally

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held to be allowable. Currently, Group II has no generic claim.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. A telephone call was made to Mr. John Penny on 1/8/01 to request an oral election to the above restriction requirement, but did not result in an election being made.
10. Any inquiry concerning this communication from the examiner should be directed to Examiner Judy Nguyen whose telephone number is (703) 305-7062. An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-0956.



Judy Nguyen